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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,535	02/09/2000	Baychar .	Bay-410-02	2745
24956	7590	07/02/2004	EXAMINER	
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			SINGH, ARTI R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/500,535	Applicant(s) ., BAYCHAR	
	Examiner Ms. Arti Singh	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22, 25, 28, 37, 39, 42, 44-45, 47, 52, 53 AND 55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks filed on 04/02/04. Applicant's amendments to claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53 and 55 along with the amendment to the title have all been entered. As Applicant's has amended to change the preambular language of the claim the previously made rejections have been withdrawn and a new rejection is set forth below. In response to Applicant's comments on 15 of the response stating that the enhanced thermal properties of are not inherent to a composite, is noted. However, when reviewing the current specification the Examiner understands that these properties exist only if the foam or the fibers are incorporated with a phase change coating or the like which assists in the wicking of moisture/vapor from one side of the composite to the other. This is not claimed, only the properties that would result from such a presence is claimed. And if this is the case, the claims need to incorporate their presence.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By adding the limitation of "footwear" it is unclear what exactly being claimed. Do you mean the entire shoe? Or a specific portion, such as the lining, tongue, insole or is the composite an integral part of the shoe? Please clarify as to what is exactly meant by this limitation. For the purposes of examination the Examiner must give such language it's broadest interpretation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5637389 issued to Colvin et al further in view of issued to Ogden et al.

6. The invention of Colvin et al. relates generally to the field of foamed insulation materials and, more particularly to insulation materials for use in a variety of application such as insulated containers, automotive interiors (i.e., seats, steering wheels, dashboards, headliners, carpet pads), meal delivery systems, footwear insulation, clothing (i.e., turn-out gear for use in fire fighting, bullet-proof vest liners, footwear liners, underwater dive suits, helmet liners), food packaging, protective packaging of other perishables and insulated bulkheads (column 1, line 13-21). In a second embodiment of the invention, an insole is adapted to be removably positioned within an article of footwear to insulate the foot from heat or cold and provide auxiliary heat from stored energy. The insole comprises a flexible resilient foam base material forming a pad. A plurality of microcapsules are integral with and dispersed throughout at least a portion of the base material and contain a temperature stabilizing means, such as a phase change material, for example, paraffinic hydrocarbons. The microcapsules are individually surroundingly encapsulated and embedded within the base material. Substantially all of the microcapsules are spaced apart from each other and the space between neighboring adjacent microcapsules is base material. Furthermore, the insole

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may include an anisotropic distribution of particles such that they are concentrated closer to the plantar region of the foot. Alternatively, the insole may be multilayered, with the upper layer containing microcapsules and the lower layer a microcapsule free insulator (column 2, lines 37-55). A plurality of microcapsules containing a phase change material are dispersed throughout the foam base material such that the microcapsules are individually surroundingly encapsulated and embedded within the base material. The foam is formed such that the microcapsules are spaced apart from each other, and further, such that the space between neighboring adjacent microcapsules contains base material. Fabric layers are attached to one or both sides of the foam, depending on the particular application involved (column 2, lines 63-67). In column 4, lines 15-18, Patentee states that the foam that is used may be open or closed celled depending upon the particular application and further is hydrophilic (column 7, line 31).

With regard to the limitation "capable of", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to perform so. It does not constitute a limitation in any patentable sense. See *In re Hutchinson*, 69 USPQ 138.

Colvin et al teaches what is set forth above but fails to expressively suggest the make up of the fabric that is used. Ogden teaches an insole made of a plurality of layers. In figure 8 and in columns 12-13 Ogden shows that his insole may be made of a top layer which has apertures, to which is attached a nonwoven layer, to which may be attached a cushionary urethane (a foam, which is a sponge rubber and generically known to be both open and closed cell foams) to which is further affixed an adhesive net. The nonwovens may be cotton or polyester.

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A person having ordinary skill in the art at the time the invention was made would have found it obvious to have employed the nonwoven layer of Ogden in the composite of Colvin et al. One would have been motivated to do this for the simple reason of using what is readily available, commonly used and inexpensive.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

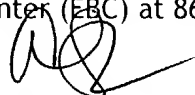
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ms. Arti Singh
Primary Examiner
Art Unit 1771

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